

The opinion in support of the decision being entered today
was **not** written for publication in a law journal and
is **not** binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUI WU, STEWART B. KELLAND and NEIL P. BOYD

Appeal No. 2003-0493
Application No. 09/108,716

ON BRIEF

Before BARRETT, FLEMING and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's
rejection of claims 31 to 50.

The Invention

The invention relates to an image-based document processing system which associates data from two types of documents, see page 2 of appellants' specification. The documents are categorized as proof and non-proof items, where proof items include documents such as checks or deposit slips and non-proof items include documents such as an adding machine tape, see page 5 of appellants' specification. These documents are scanned, recognition software determines information, such as the amount identified on the check, which is stored along with the image. The data is organized into two lists, the primary list contains data such as debit or credit amounts from checks or deposit slips and the second list contains distinct elements that correspond to amounts obtained from deposit slips or adding machine tape, see page 7 of appellants' specification. The system to correlate data from the two lists uses a window for each list to frame a number of discrete elements, see page 8 of appellants' specification. The system then compares values in the window of each list to determine if there are any matches.

Claim 31 is representative of the appellants' invention and a copy of this claim is appended to this decision.

References

Thompson	U.S. Patent 5,530,773	June 25, 1996
Elischer et al. (Elischer)	U.S. Patent 5,040,226	August 13, 1991

Rejections at Issue

Claims 31, 35, 36, 40, 41, 45, 46, and 50 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thompson in view of Applicants' disclosure of well-known art.

Claims 32 through 34, 37 through 39, 42 through 44 and 47 through 49 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thompson in view of Applicants' disclosure of well-known art and Elischer.

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief¹ along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and examiner, for the reasons stated *infra* we reverse the examiner's rejections of claims 31 through 50 under 35 U.S.C. § 103. Appellants argue on page 5 of the brief, that: "the mere fact that the

¹This decision is based upon the Appeal Brief received August 23, 2001 (certified as being filed on August 21, 2001, in accordance with 37 C.F.R. § 1.8(a)).

use of a window to frame elements is well known is insufficient to support a legal conclusion of obviousness under 35 U.S.C. section 103(a)” and that the examiner needs to explain why a person of ordinary skill in the art would be motivated to make the combination of Thompson and the well known art. Before we consider the art used in the rejection we must first determine the scope of the claim. Claims will be given their broadest reasonable interpretation consistent with the specification, limitations appearing in the specification will not be read into the claims. *In re Etter* 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellant’s disclosure to properly determine the meaning of the terms used in the claims. *Markman v Westview Instruments*, 52 F3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). “[I]nterpreting what is *meant* by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (emphasis original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing *Intervet America Inc v. Kee-Vet Laboratories Inc.* 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)).

Appellants identify on page 4 of the brief that:

Each of the claims 31-50 recites, inter alia, “... placing a first window of a first predetermined size over the first set of global elements from the primary list to define a first set of local elements which is a subset of the first set of global elements ...” and “ ... placing a second window of a second predetermined size over the second set of global elements from the secondary list to define a second set of local elements which is a subset of the second set of global elements...”

We concur, and find that each of independent claims 31, 36, 41 and 46, contains this limitation. The term “window” used in this limitation is however not defined in the specification. Page 8 of the appellants’ specification contains a description of a window stating “[t]he use of a window to frame and thereby select particular elements for further consideration thereof is well known...” Thus, we construe the term window to be a device to select a number of elements for further consideration. We note that appellants’ specification makes no mention of the window being a visual display type of window, according we hold that the scope of the window limitation does not include a visual type window.² In the context of the claims these windows are to select a number of elements in a list, the elements selected are titled “local elements.” Further, we note that the claim language that the window “defines a first set of local elements” necessarily requires that the window contain more than one element.

The examiner responds to the appellants’ argument concerning the lack of motivation, on page 11 of the answer, by providing the rationale that “[u]sing a window to frame the individual values makes it easier for a user to control or view the individual chosen items.” On page 11 of the answer, the examiner argues that Thompson’s items 18 or 20 meet the claimed “local elements.”

² Though figure 2 of appellants’ specification shows windows items 51 and 52, Figure 2 is described, on page 4 of appellants’ specification, as a “diagrammatic illustration” and not as a sample of a display produced by the device.

We do not find the examiner's reasoning to be convincing. An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). When determining obviousness, "[t]he factual inquiry whether to combine references must be thorough and searching." *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433, *citing McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). "It must be based on objective evidence of record." *Id.* "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617, *citing McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). The Federal Circuit states that, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification."

In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), citing ***In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In addition, our reviewing court stated in ***Lee***, 277 F.3d at 1343, 61 USPQ2d at 1433, that when making an obviousness rejection based on combination, “there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant” (quoting ***In re Dance***, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)).

As stated *supra* we find that the scope of the independent claims includes that the window select a number, more than one, of elements in a list to be considered. We note that the examiner has not relied upon evidence of record to provide the motivation, to modify Thompson to make use of a window. We find that the motivation asserted by the examiner is not related to the claimed invention. As stated *supra* we do not find that the scope of the limitation of a first and second window to include a visual component. As such, we find that the motivation “using a window... makes it easier for a user to control or view the individual chosen items” is not logically related to the claimed invention.

Additionally, we find that Thompson neither teaches a window nor provides suggestion to use a window. We find that Thompson teaches a method to correlate entries on an adding machine tape with the amount on a check (Thompson, Column 4, lines 11-14). The adding machine tape and check entries are on two lists (Thompson,

Column 4, lines 55-61). Thompson's method sequentially goes through the entire list to determine matches (see e.g. Thompson, Column 5, lines 19-44). Thompson does not teach that a subset, a selected number of elements, of either of the lists is used in the process of determining matches. Accordingly, we will not sustain the rejection of claims 31, 35, 36, 40, 41, 45, 46, and 50 under 35 U.S.C. § 103 as being unpatentable over Thompson in view of Applicants' disclosure of well-known art.

Finally, we turn to the rejection of Claims 32 through 34, 37 through 39, 42 through 44 and 47 through 49 under 35 U.S.C. § 103 as being unpatentable over Thompson in view of Applicants' disclosure of well-known art and Elischer. These claims are ultimately dependent upon claims 31, 36, 41 or 46 and as such include the limitation of a "window" as described *supra*. On page 10 of the answer, the examiner, states that Elischer is relied upon to teach modifying Thompson to "calculate a value based upon the recognition results from the primary and secondary lists when an exact match fails to occur and compare the value with a predetermined value to allow a determination to be made as to whether there is an approximate match between recognition results from the primary and secondary lists." The examiner has not shown that Elischer teaches or suggests the limitation of a "window" as described *supra*. Accordingly, we will not sustain the rejection of claims 32 through 34, 37 through 39, 42 through 44 and 47 through 49 under 35 U.S.C § 103, as it contains the same deficiencies as noted in the rejection of claims 31, 35, 36, 40, 41, 45, 46, and 50 under 35 U.S.C § 103.

Appeal No. 2003-0493
Application No. 09/108,716

In view of the forgoing we will not sustain the rejection of claims 31 through 50 under 35 U.S.C. § 103. Therefore the decision of the examiner rejecting claims 31 through 50 is reversed.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
)	
)	
MICHAEL R. FLEMING)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
ROBERT E. NAPPI)	
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Appeal No. 2003-0493
Application No. 09/108,716

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APPENDIX
Claim 31

31. A method of processing documents in an image-based document processing system to associate recognition results from a primary source results list with corresponding recognition results from a secondary source results list to improve assistance to an operator of the image-based document processing system during operation of the image-based document processing system, the method comprising the steps of :

- (a) scanning a first type of document to obtain scanned data representative thereof,
- (b) scanning a second type of document to obtain scanned data representative thereof,
- (c) processing scanned data representative of the first type of document to provide recognition results associated with the first type of document;
- (d) processing scanned data representative of the second type of document to provide recognition results associated with the second document;
- (e) storing recognition results associated with the first type of document in a primary list, wherein the recognition results associated with the first type of document comprise a first set of global elements;
- (f) storing recognition results associated with the second type of document in a secondary list, wherein the recognition results associated with the second type of document comprise a second set of global elements;
- (g) placing a first window of a first predetermined size over the first set of global elements from the primary list to define a first set of local elements which is a subset of the first set of global elements;

(h) placing a second window of a second predetermined size over the second set of global elements from the secondary list to define a second set of local elements which is a subset of the second set of global elements;

(i) comparing an element of the first set of global elements from the primary list with an element of the second set of global elements from the secondary list to determine if there is an exact global match therebetween; and

(j) comparing an element of the first set of local elements from the primary list with an element of the second set of local elements from the secondary list to determine if there is an approximate local match therebetween when an exact global match fails to occur in step (i).